

## **REMARKS**

The Office Action mailed February 11, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

### **I. Discussion of Information Disclosure Statement**

When submitting the Information Disclosure Statement of October 18, 2002, the Applicants also submitted copies of the references listed on the PTO Form 1449. As the Examiner did not receive these references, the Applicants submit with this Amendment the previously-submitted Information Disclosure Statement, including the PTO Form 1449, and a stamped postcard acknowledging receipt of the Information Disclosure Statement with references on October 18, 2002. In addition, copies of the references that are not initialed by the Examiner are submitted.

### **II. Discussion of Objections to the Specification**

The Examiner effectively indicates that it is improper to incorporate by reference a document that, in turn, incorporates another document by reference. The Applicants respectfully invite the Examiner to provide support for this assertion. More particularly, the Applicants invite the Examiner to provide a reference to a legal source (i.e., laws, regulations, the MPEP) that supports this assertion.

The Examiner also objected to the specification and requested that "chamber 14" be amended throughout the specification to "insert 14", for example. The Applicants have reviewed the specification and submit that "chamber 14" is appropriate terminology. A chamber may have many sub-chambers that are effectively chambers in and of themselves. Accordingly, chamber 14 includes the one or more chambers 13.

### **III. Discussion of Restriction Requirement**

In the Response to Restriction Requirement filed November 26, 2003, Applicants elected the species of Figures 1-7 and submitted that claims 1-8, 11-15, 18-25, and 29-34 were readable thereon. In the outstanding Office Action, the Examiner states that the Applicants' election is acknowledged, and the election is made final, without any additional discussion. The Office

Action also indicates, however, that each of claims 9-17 and 26-28 are withdrawn from consideration. In contrast with the claims indicated as withdrawn in the Office Action, Applicants actually withdrew only claims 9-10, 16-17, and 26-28. Applicants submit, therefore, that only claims 9-10, 16-17, and 26-28 are withdrawn from consideration.

#### **IV. Summary of Claims**

Claims 1-34 are currently pending in the application, with claims 1, 18, 29, and 32 being independent claims. Claims 29 and 32 are amended. The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-5 and 29 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 2,762,134 to Town;
- Claims 1-6, 18-23, 29, and 32 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,979,078 to McLaughlin;
- Claims 18-22 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Town and U.S. Patent Number 2,677,906 to Reed; and
- Claims 7-8, 24-25, 30-31, and 33-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of McLaughlin and U.S. Patent Number 5,902,660 to Huang.

#### **V. The Claims Patentably Distinguish Over The Applied Prior Art**

##### *Discussion of Independent Claim 1*

Independent claim 1 recites various features of a bladder for an article of footwear. The bladder includes a sealed first chamber and a sealed second chamber. The first chamber is formed of a barrier material and contains a fluid at a first fluid pressure. The second chamber is formed of a second barrier material and contains a fluid at a second fluid pressure that is greater than the first fluid pressure. The second chamber is operatively coupled to the first chamber such that the inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber, thereby increasing the fluid pressure and the amount of fluid within the first chamber.

Independent claim 1 is rejected as being anticipated by Town, which discloses a cushioning insole design for footwear. The insole includes an outer chamber and an inner

chamber, the inner chamber being positioned within the outer chamber. Referring to the figures in Town, the outer chamber is formed from two sheets of material 10 and 11, and the inner chamber is formed from two sheets of material 14 and 15.

In contrast with Town, independent claim 1 recites that the first chamber contains a fluid at a first fluid pressure, the second chamber contains a fluid at a second fluid pressure, and the second fluid pressure is greater than the first fluid pressure. Referring to Town, however, there is no teaching relating to the relative pressures between the outer and inner chambers. More particularly, Town does not disclose the concept of inflating the two chambers to different pressures.

Independent claim 1 also recites that the inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber. Referring to Town, however, there is no indication that the fluid within the inner chamber, for example, leaves the inner chamber and enters the second chamber. That is, Town does not disclose the concept of fluid being transferred between the various chambers.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over Town. In addition, claims 2-5 should be allowable for at least the same reasons and by virtue of the additional limitations recited therein.

Independent claim 1 is also rejected as being anticipated by McLaughlin, which discloses a cushioning device for footwear. The cushioning device includes a first chamber and a second chamber that is positioned within the first chamber. As stated in McLaughlin, "The formation of multiple internal chambers...permits the separate chambers to be pressurized at various desirable pressures and the development of a multi-stage cushioning system. First inner bladder 15 is inflated to a higher pressure than that contained with second outer bladder 17. Inner bladder 15 is inflated to a pressure between 5 and 30 p.s.i., preferably between 20 p.s.i. and 30 p.s.i., whereas outer bladder 17 is maintained between atmospheric pressure and 15 p.s.i., preferably less than 5 p.s.i." (see McLaughlin, column 5, lines 18-27).

In contrast with McLaughlin, independent claim 1 recites that the inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber. There is no indication in McLaughlin, however, that fluid within the second chamber moves into the first

chamber. That is, McLaughlin does not disclose the concept of a transfer of fluids between the chambers.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over McLaughlin. In addition, claims 2-6 should be allowable for at least the same reasons and by virtue of the additional limitations recited therein. Claims 7 and 8 are also rejected over the combination of McLaughlin and Huang. Huang, however, does not remedy the deficiencies of McLaughlin discussed above. Accordingly, claims 7 and 8, which incorporate the recitation of independent claim 1, should be allowable for at least the same reasons.

#### *Discussion of Independent Claim 18*

Independent claim 18 recites various features of an article of footwear that includes an upper for covering at least a portion of a foot of a wearer and a sole unit attached to the upper. The sole unit includes a shock absorbing system with a bladder that has a sealed first chamber and a sealed second chamber. The first chamber is formed of a first barrier material and contains a gas at a first fluid pressure, and the second chamber is formed of a second barrier material and contains a gas at a second fluid pressure that is greater than the first fluid pressure. The second chamber is operatively coupled to the first chamber to release gas from the second chamber to the first chamber to replenish the first chamber with gas.

Independent claim 18 is rejected as being anticipated by McLaughlin. In contrast with McLaughlin, independent claim 18 recites that gas is released from the second chamber to the first chamber to replenish the first chamber with gas. There is no indication in McLaughlin, however, that fluid within the second chamber moves into the first chamber. That is, McLaughlin does not disclose the concept of a transfer of fluids between the chambers.

Based upon the above discussion, the Applicants respectfully submit that independent claim 18 is allowable over McLaughlin. In addition, claims 19-23 should be allowable for at least the same reasons and by virtue of the additional limitations recited therein. Claims 24 and 25 are also rejected over the combination of McLaughlin and Huang. Huang, however, does not remedy the deficiencies of McLaughlin discussed above. Accordingly, claims 24 and 25, which incorporate the recitation of independent claim 18, should be allowable for at least the same reasons.

Independent claim 18 is also rejected as being obvious over the combination of Town and Reed. Whereas the Examiner utilizes Town in the manner applied to independent claim 1, Reed is merely utilized to teach the concept of an upper.

In contrast with Town, independent claim 18 recites that the first chamber contains a fluid at a first fluid pressure, the second chamber contains a fluid at a second fluid pressure, and the second fluid pressure is greater than the first fluid pressure. Referring to Town, however, there is no teaching relating to the relative pressures between the outer and inner chambers. More particularly, Town does not disclose the concept of inflating the two chambers to different pressures.

Independent claim 18 also recites that gas is released from the second chamber to the first chamber to replenish the first chamber with gas. Referring to Town, however, there is no indication that the fluid within the inner chamber, for example, leaves the inner chamber and enters the second chamber. That is, Town does not disclose the concept of fluid being transferred between the various chambers.

Based upon the above discussion, the Applicants respectfully submit that independent claim 18 is allowable over the combination of Town and Reed. In addition, claims 18-22 should be allowable for at least the same reasons and by virtue of the additional limitations recited therein.

#### *Discussion of Independent Claims 29 and 32*

Independent claim 29 recites the features of an inflatable bladder for an article of footwear. The bladder includes a sealed first chamber and a sealed second chamber. The first chamber is formed of a barrier material and contains a gas at a first pressure. The second chamber is formed of a barrier material and contains a gas at a second pressure that is greater than the first pressure. The second chamber is operatively coupled to the first chamber so that the gas from the second chamber is released into the first chamber to replenish the first chamber with gas when the barrier material of the second chamber experiences fatigue failure. The second chamber is structured to experience the fatigue failure following a predetermined number of cycles of compression or flex. Independent claim 32 incorporates a substantially similar recitation for an article of footwear having an upper and a sole unit attached to the upper.

Neither Town, McLaughlin, nor the combination of Town and Reed disclose the concept of structuring the second chamber to experience the fatigue failure following a predetermined number of cycles of compression or flex. The Applicants respectfully suggest that one of ordinary skill in the art would understand the disclosure of Town, McLaughlin, and Reed as teaching an intent for the bladders to retain the disclosed, non-fatigue failed structure throughout the life of the footwear. More particularly, Town, McLaughlin, and Reed incorporate no indication that one of the chambers is *structured* to experience the fatigue failure following a predetermined number of cycles of compression or flex.

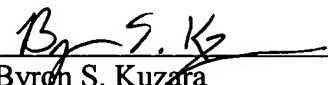
Based upon the above discussion, the Applicants respectfully submit that independent claim 29 is allowable over both Town and McLaughlin, and independent claim 32 is allowable over both McLaughlin and the combination of Town and Reed. In addition, claims 30-31 and 33-34 should be allowable over McLaughlin and Huang for at least the same reasons and by virtue of the additional limitations recited therein.

## **VI. Conclusion**

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being filed with a one-month petition for extension of time. Should additional fees be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

By:   
Byron S. Kuzara  
Registration No. 51,255

Banner & Witcoff, Ltd.  
1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Telephone: (202) 824-3000  
Dated: May 11, 2004